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In re Application of  
Maria Grazia Pau  
Application No. 09/449, 854  
Filed: November 26, 1999  
Attorney Docket No. 4240US

Paper No. 14  
**COPY MAILED**

JUN 30 2003

**OFFICE OF PETITIONS**  
DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed May 22, 2002, to revive the above-identified application.

The petition is **DISMISSED**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 CFR 1.137." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

BACKGROUND

The above-identified application became abandoned for failure to timely and properly reply to the Office communication mailed January 15, 2002, which set a one (1) month period for reply. Petitioner filed a Response to Notice to Comply on February 18, 2002, traversing the requirements of the communication and notice, and requesting clarification. No further filings were forthcoming. Accordingly, the application became abandoned on February 16, 2002. A Notice of Abandonment was mailed on March 12, 2002.

THE INSTANT PETITION

Petitioner responds with the instant petition wherein Petitioner argues that the Office Communication failed to indicate the location in the application wherein a nucleotide or amino acid sequence coming within the requirements of 37 C.F.R. 1.821-1.825 could be found. Petitioner contends that "[w]ithout awareness of the nature of the nucleotide or amino acid sequence for which a listing was requested, Applicants could do little more than request clarification, as was timely done." Petitioner argues that the requested clarification was not timely provided by this Office, and the application thus proceeded to abandonment.

APPLICABLE LAW

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: (1) the required reply (unless previously filed), which may be met by the filing of a notice of appeal and the requisite fee; a continuing application; an amendment or request for reconsideration which *prima facie* places the application in condition for allowance, or a first or second submission under 37 CFR 1.129(a) if the application has

been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 U.S.C. 120, 121 and 365(c); (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c). The instant petition lacks item (3).

**Petitioner has not provided an adequate showing of unavoidable delay**

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Moreover, a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (1) the applicant's reliance upon oral advice from Office employees; or (2) the Office's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985); see also In re Colombo, Inc., 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994) (while the Office attempts to notify applicants of deficiencies in their responses in a manner permitting a timely correction, the Office has no obligation to notify parties

*of deficiencies in their responses in a manner permitting a timely correction) (Emphasis supplied).*

#### ANALYSIS

As to item (3), *In re Sivertz* is applicable. The Notice clearly required a Sequence Listing, which Petitioner has, without having received clarification from this Office to date, supplied. Moreover, and as iterated in *In re Colombo, Inc.*, the Office has no obligation to notify Petitioner of deficiencies in a manner permitting timely correction. Petitioner's assertion, that the Office failed to contact Petitioner with appropriate clarification, is without merit. Petitioner is directed to the MPEP, section 711.02, which reads:

37 CFR 1.135(a) specifies that an application becomes abandoned if applicant "fails to reply" to an office action within the fixed statutory period. This failure may result either from (A) failure to reply within the statutory period, or (B) insufficiency of reply, i.e. failure to file a "complete and proper reply, as the condition of the case may require" within the statutory period (37 CFR 1.135(b)).

This section clearly explains that abandonment occurs when Petitioner fails to timely and properly reply to the outstanding Office action.

This section is further clarified in the Manual of Patent Examining Procedure ("MPEP"), which provides

[f]or example, as 37 CFR 1.116 and 1.135(b) are manifest that proceedings concerning amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal, a delay is not 'unavoidable' when the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action.

MPEP § 711.03(c).

In this instance, Petitioner permitted the reply period to expire while awaiting a response from this Office. As the MPEP provides, a delay is not unavoidable in this instance.

#### CONCLUSION

Petitioner has failed to demonstrate that the delay in filing a timely and proper reply to the final Office action, mailed January 15, 2002, was unavoidable.

#### ALTERNATE VENUE

Petitioner is strongly urged to file a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended

35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable." This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Finally, the Sequence Listing, filed May 22, 2002, has been entered and made of record.

Further correspondence with respect to this matter should be addressed as follows:

By mail:           Commissioner for Patents  
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Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-0014.

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